

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-4 and 6-22 remain pending. Claims 1, 6, and 10 are independent.

SUMMARY OF THE OFFICE ACTION

The outstanding Action has been made final and again acknowledges the claim for foreign priority and receipt of the priority document as well as acknowledging that the drawings filed February 18, 2004, have been accepted. The outstanding final Action also presents a rejection of claims 1-4 and 6-22 under 35 U.S.C. § 103 as allegedly being unpatentable over "Spyglass Prism" (Concepts and Applications: Spyglass Prism, 1997) (hereinafter "Spyglass") in view of Fox et al. (an article entitled "Reducing WWW Latency and Bandwidth Requirements by Real-Time Distillation") (hereinafter "Fox") further in view of U.S. Patent No. 6,167,441 to Himmel (hereinafter "Himmel") and still further in view of U.S. Patent Application Publication No. 2002/ 0026475 to Marmor (hereinafter "Marmor").

REJECTION OF CLAIMS 1-4 AND 6-22

Page 2 of the outstanding Action presents a rejection of claims 1-4 and 6-22 under 35 U.S.C. § 103 as allegedly being unpatentable over Spyglass in view of Fox, further in view of Himmel, and still further in view of Marmor. This rejection is traversed.

The present Office Action fails to respond to previously presented arguments as to deficiencies in the asserted combination of Spyglass Prism and Fox from the After-Final Reply dated March 6, 2008 and from the RCE Amendment filed April 8, 2008 even though this reliance on Spyglass and Fox has not changed since these filings. The examiner has further failed to respond to the new arguments pointing out the deficiencies in the asserted combination of Spyglass Prism and Fox appearing at the bottom of page 9, to the top of page 11 of the last response filed August 4, 2008, as well as the arguments directed to the deficiencies of Himmel that appear in the two full paragraphs on page 13 of this response filed August 4, 2008. These arguments are all herein incorporated by reference as they have not been rendered moot by the outstanding Action simply relying on a new reference to Marmor that has been added because the PTO at long last has admitted that Fox-Spyglass-Himmel does not disclose that there is any

query for destination information as it is stored in a gateway so that no querying is done (see the start of the full paragraph at the bottom of page 5 of the outstanding Action).

In this last regard, no matter what Marmar is relied on to teach, the fact remains that claim limitations in a means-plus-function (35 U.S.C. §112, 6th paragraph) form must be addressed by the PTO as dictated by the decisions noted in the last response that are repeated as follows:

It is by now well established that the first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 [58 USPQ2d 1801, 1806] (Fed. Cir. 2001). It is further well established that the PTO must demonstrate that the references relied upon teach the same function that is claimed. *See Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997).

It is clear from the outstanding Action that no attempt is made to define the particular functions of any claim much less to demonstrate how the relied on references then teach exactly the claimed function. For example claim 1 recites “terminal information acquiring means for receiving the image and information designating the destination terminal from an image sending terminal, the image sending terminal is different from the destination terminal, thereafter requesting the destination terminal designated by the image sending terminal to provide destination terminal information about the destination terminal, and acquiring the requested destination terminal information from the destination terminal.” Rather than showing how the references in combination teach an equivalent structure to that disclosed for performing exactly this function, the references are relied on as to their showings of entirely different elements to perform only disjointed parts of the above-noted claim 1 recited function.

In this regard, the first full paragraph on page 3 of the outstanding Action alleges that Spyglass teaches “terminal information acquiring means for acquiring a destination terminal information about the destination terminal” because the user can be asked to store user conversion preferences into a user data base. Missing here is how the user entry can be said to be the claimed “terminal information acquiring means” or how this user entry and transaction manager are to be modified so as to also perform the other recited functions of “receiving the image and information designating the destination terminal from an image sending terminal, the

image sending terminal is different from the destination terminal, thereafter requesting the destination terminal designated by the image sending terminal to provide destination terminal information about the destination terminal, and acquiring the requested destination terminal information from the destination terminal.”

Instead of addressing this express claim language and showing how the relied on references teach the claimed “terminal information acquiring means” that performs all of these claimed functions, the paragraph bridging pages 4 and 5 of the outstanding Action simply points out that the combination of Fox-Spyglass do not teach functions that are similar to but not the same as those noted above. In this regard, this paragraph notes that Fox-Spyglass “do not expressly disclose requesting from the destination terminal device the destination terminal information about the destination terminal and receiving the information from the destination terminal upon receipt of an image to be converted.” However, the above noted *Gechter* decision makes it clear that the PTO must demonstrate that the references relied upon teach the same function that is claimed and not some paraphrased function that is different. The claimed function expressly recited by claim 1 that is relevant is that of “receiving the image and information designating the destination terminal from an image sending terminal, the image sending terminal is different from the destination terminal,” and not simply “receiving the information from the destination terminal upon receipt of an image to be converted” as noted here.

Thus, the outstanding Action is deficient because it never addresses the above noted claim 1 language requiring “receiving the image and information designating the destination terminal from an image sending terminal, the image sending terminal is different from the destination terminal,” much less to identifying “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter” as required by MPEP § 706.02(j). As explained in this section of the MPEP, such an explanation is necessary because “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” This is more than mere guidance by the MPEP as 35 U.S.C. § 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly,

setting forth all relied on rationales to support the rejection including treatment of all claim limitations and reference modifications in a way that gives the applicant a fair opportunity to respond is mandated by the statute and something that the outstanding Action completely and improperly ignores as to the image sending terminal language of claim 1 that is noted above..

The above-noted paragraph continues on page 5 by suggesting that Himmel discloses "sending a request to a destination terminal for capabilities information to be used to convert incoming images" with reference to Figure 6 teachings of "choose image which looks best" and "what type of computer is the destination device." However, the in context teachings of Himmel were fully discussed at the bottom of page 13 of the last response as follows;

Himmel relates to customizing the selection of Web pages in an Internet environment based on the requesting client device (see column 1, lines 7 to 9). One of the objects of Himmel is to determine the type of client device which is requesting services from a web server (see column 2, lines 20 to 22). A client browser 151 resident at one of the client devices issues an HTTP request 153 for an HTML page at a particular URL. The request is directed to the client-smart agent 155 which first attempts to identify the client using the HTTP header information. If this is unsuccessful, the client-smart agent downloads 157 a client-snooper agent 159 to the client to get the information necessary about the client device to choose an appropriate web page (see column 6, lines 45 to 54). Himmel merely acquires information about the requesting client device. Himmel does not disclose or suggest the feature "acquiring the requested destination terminal information from the destination terminal" that is different from the image sending terminal, such that programming choices, simple or complex would not have led the artisan to the claimed subject matter.

The reliance on FIG. 6 of Himmel does not change the fact that Himmel merely acquires information about the requesting client device and does not teach or suggest the claim 1 feature of "acquiring the requested destination terminal information from the destination terminal" that is different from the image sending terminal." In this regard, and as noted in Himmel, if the snooper is not effective, then the "user can be afforded an opportunity to select the 'page formatting' from a list," where a "sample page is shown in FIG. 6."

Furthermore, even if Himmel taught "acquiring the requested destination terminal information from the destination terminal," which is not the case, there is nothing suggesting any query being done after "receiving the image and information designating the destination terminal from an image sending terminal, the image sending terminal is different from the destination terminal" as

claim 1 recites. Instead of addressing the actual claim limitation and producing the “substantial evidence” relating to this limitation that is required by the Administrative Procedure Act, the outstanding Action once again relies on a completely unsubstantiated conclusion that even though Himmel does not expressly disclose that there is any query to be done in response to receiving an image, much less that the image must be received from an image sending terminal that is different from the destination terminal, one skilled in the art would modify Himmel to make a query in response to receiving an image “as a simple programming choice.” This approach of substituting subjective conclusions for actual evidence is clearly erroneous as explained by the PTO reviewing court. *See In re Lee*, 217 F.3d 1365, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) as follows:

Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies. *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). Thus on appeal we review a PTO Board's findings and conclusions in accordance with the following criteria:

- 5 U.S.C. 706(2) The reviewing court shall
- (2) hold unlawful and set aside agency actions, findings, and conclusions found to be
 - (A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;
* * * *
 - (E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute;

For judicial review to be meaningfully achieved within these strictures, the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts.

The *Lee* court went on to expressly note (at 277 F.3d 1345, 61 USPQ2d 1435) that “when they [the Board or the Examiner] rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record.” Thus, the mere presentation of the conclusion that even though Himmel does not expressly disclose that any query

is done in response to receiving an image from anywhere, one skilled in the art would easily make this modification as a simple programming choice is clearly an insufficient substitute for the required showing of substantial evidence.

The outstanding Action further states (at the bottom of page 5) that “Fox-Spyglass-Himmel does not explicitly disclose that the converter queries the receiver for destination information, rather the destination information is stored in the gateway and no querying is done,” which storage appears to relate to the Spyglass teaching of maintaining a database with such destination capabilities already stored therein. The outstanding Action nevertheless relies on teachings from Marmor that would eliminate this Spyglass teaching of maintaining a database with such destination capabilities already stored therein that would change this operating principle of Spyglass if adopted.

In this regard, to whatever extent that paragraphs [0028] and [0103] Marmor disclose a converter that queries a client for that client’s capabilities, this disclosure cannot be used to modify the Spyglass teaching of maintaining a database with such capabilities already stored therein without eliminating this database and adopting the Marmor approach of obtaining such capabilities from the client. Such a proposed modification that would require a complete redesign and change the basic operating principle of the reference being modified (the Spyglass database) is not considered by the courts to be an obvious one. *See In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

As the above-noted limitations of claim 1 are not even remotely suggested by the Spyglass disclosure and none of the secondary references to Fox, Himmel or Marmor make up for the above-noted deficiencies of Spyglass, Applicant submits that the rejection of claim 1 under 35 U.S.C. § 103 as allegedly being unpatentable over Spyglass in view of Fox, further in view of Himmel, and still further in view of Marmor is in error and the withdrawal of this improper rejection is respectfully requested.

As independent claims 6 and 10 incorporate subject matter that parallels the subject matter of claim 1, Applicant submits that this rejection of claims 6 and 10 under 35 U.S.C. § 103 as allegedly being unpatentable over Spyglass in view of Fox, further in view of Himmel, and

still further in view of Marmor also cannot be reasonably asserted to be proper and the withdrawal thereof is, therefore, respectfully requested.

Furthermore, as claims 2-4 and 11-14 depend directly or indirectly from independent claim 1, claims 7-9 and 15-18 depend directly or indirectly from independent claim 6, and claims 19-22 depend directly or indirectly from independent claim 10, these dependent claims are believed to patentably define over the applied references at least for the same reasons their corresponding parent independent claim does. In addition, all of these dependent claims add further features not taught or suggested by any of the applied references and should be considered to patentably define there over for this reason as well. Thus, the withdrawal of the rejection of claims 2-4, 7-9, and 11-22 under 35 U.S.C. § 103 as allegedly being unpatentable over Spyglass in view of Fox, further in view of Himmel, and still further in view of Marmor is further respectfully requested.

Improper Interpretation of MPEP §2144.03 and the Cited Decision

Also, the outstanding Action (at pages 8 and 9) improperly relies on MPEP § 2144.03 as providing the PTO authority to ignore arguments previously presented that traversed the improper use of official notice. However, MPEP § 2144.03 specifically recognizes that the case law (e.g., *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, (CCPA 1970) noted in MPEP §2144.03) establishes that if official notice is used at all, it can only be used to "fill in the gaps" in an **insubstantial manner** which might exist in the evidentiary showing to support a particular ground for rejection. This section specifically points out that such notice ("well known") is not to be used as to "assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art" because such technical facts "must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21."

The Examiner cannot use such improper application of "Official Notice" to create an implied admission as to any "prior art" status. Note again the remarks at pages 11-12 of the last response repeated as follows:

It is noted that the paragraph bridging pages 8 and 9 of the outstanding Action misinterprets MPEP §2144.03 as establishing a legal principle. However, the MPEP does not have the force of law, and is entitled to legal effect only as to representing the PTO interpretation of statutes and regulation. See *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n.10, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995). Moreover, this section itself notes the controlling decision of *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as establishing that the PTO can never rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. Nothing in the PTO improper interpretation of *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943) can overrule *Zurko* by creating a PTO interpreted rule of admitted prior art. In this last respect the court in *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943) only noted that they would not consider the argument challenging the PTO position as it had not been made before the PTO, not that they considered there to be any admitted prior art because the Applicant did not challenge the assertion at the very first opportunity in the reply to the Action which made the assertion.

Also, nothing in *Chevenard* supports the apparent PTO interpretation that anything more than a demand for evidence is required to put the PTO to its duty of supplying evidence under the applicable law, not mere opinion and unsupported conclusions. See *In re Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002), as follows:

In finding relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administration procedure or effective judicial review.

In accordance with the above noted legal precedent, it is demanded that the PTO carry its burden under the Administrative Procedure Act and produce the substantial evidence required thereby as to the mere conclusions of knowledge in the art offered as to the rejection of claim 1 based on asserted but unproven "programming choice" at page 5, lines 12-13, of the outstanding Action; the rejection of claim 12 based on the mere conclusion offered at page 7 of the outstanding Action as to a cellular network bandwidth being lower than that of an undefined wired network; and assertions as to cellular phones and JPEG made at page 8 of the outstanding Action relative to Claims 13 and 14.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,



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